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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,478	09/09/2003	Pierre Dobrovoly	7236	2041

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Zenith Electronics Corporation
2000 Millbrook Drive
Lincolnshire, IL 60069

EXAMINER

TRAN, PABLO N

ART UNIT PAPER NUMBER

2618

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/658,478

Applicant(s)

DOBROVOLNY, PIERRE

Examiner

Pablo N. Tran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 1-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 19, 22, 23, 28 and 35-37 is/are rejected.
- 7) ☒ Claim(s) 20-21, 24-27, and 29-34 is/are objected to.
- 8) ☒ Claim(s) 1-37 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18, drawn to a tuner having a feedback circuit to provide first and second outputs representing power of the attenuated signal and wherein the feedback circuit coupled to control the attenuation.
 - II. Claims 10-13, drawn to a tuning method to inhibit overloading of the mixer.
2. The inventions are distinct, each from the other because:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Group I drawn to tuner having a feedback circuit, as stated above, and Group II has separate utility such as a tuning method to inhibit overloading of the mixer. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their recognized divergent subject matter and different searches are required for each group.
4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. During a telephone conversation with Mr. Trevor Joike (Reg No. 25542) on April 27, 2006, a provisional election was made with traverse to prosecute the invention of Group II, claims 19-37. Claims 1-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 22 recites the limitation "the first and second". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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10. Claims 19, 22-23, 28, 35, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Zuckerman (6,169,912).

As per claim 19, Zuckerman disclose tuning method comprising the steps of attenuating (fig. 4/no. 14, col. 2/ln. 21-22) an RF signal received at an RF input, mixing (fig. 4/no. 28) the attenuated signal with a local oscillator signal (fig. 4/no. 46, 48, 62) to produce an intermediate frequency signal, developing a signal representing the power of the attenuated signal (output of IF amplifier, fig. 4/no. 32), and controlling the attenuation of the RF signal in response to the signal representing the power of the attenuated signal so as to inhibit overloading of the mixer 9col. 9/ln. 19-21).

As per claim 22, Zuckerman disclose filtering at least one of the first and second signals with a filter (fig. 4/no. 30, 36) and mixing (fig. 4/no. 34) the filtered one the first and second outputs of the filter with the local oscillator signal.

As per claim 23, Zuckerman disclose broadband filter (fig. 4/no. 30, 36).

As per claim 28, Zuckerman disclose mixing (fig. 4/no. 28) the RF signal with a first oscillator signal to produce an intermediate frequency signal and mixing (fig. 4/no. 34) the intermediate frequency signal with a second oscillator signal to produce a final intermediate frequency signal.

As per claim 35, Zuckerman disclose attenuating of an RF signal received at an RF input (fig. 4/no. 14, col. 2/ln. 21-22).

As per claim 37, Zuckerman disclose a gain controllable amplifier (col. 20/ln. 5, col. 20/ln. 66).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zuckerman (6,169,912). In view of Muterspaugh (6,434,374).

As per claim 36, Zuckerman disclose an attenuator but not explicitly a PIN attenuator. Muterspaugh teach a PIN attenuator (fig. 1/no. 144). Since both reference disclosed method of tuning, therefore, it would have been obvious to one of ordinary skill in the art to provide a PIN attenuator, as taught by Muterspaugh, to the tuner of Zuckerman in order to carry out gain adjustment all over a frequency band with high accuracy.

Allowable Subject Matter

13. Claims 20-21, 24-27, and 29-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo Tran whose telephone number is (571)272-7898.

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The examiner normal hours are 9:30 -5:00 (Monday-Friday). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (571)272-7899. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) System. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-directauspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 6, 2006

PABLO N. TRAN
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to be 'P. Tran', with a long horizontal flourish extending to the right.

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